

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARDPRO-FOOTBALL, INC. and NFL
PROPERTIES, LLC.,

Opposers,

v.

PEAK PERFORMANCE PRODUCTION AB

Applicant.

Opposition No. 91168674

76/570,322

**APPLICANT'S BRIEF IN OPPOSITION TO
OPPOSERS' MOTION FOR LEAVE
TO AMEND THE NOTICE OF OPPOSITION**

Applicant, Peak Performance Production AB, hereby opposes Opposers's Motion for Leave to Amend the Notice of Opposition ("Motion for Leave"). The basis of the proposed amendment is "legally insufficient", and fails to state a claim upon which relief can be granted. Additionally, the timing of the filing of the Motion for Leave, and context within which it was filed, argues for its denial. Accordingly, Applicant respectfully submits that Opposer's belated Motion for Leave should be denied.

Counter Statement of Facts

Both parties timely served written discovery. In response to the outstanding written discovery, both parties served responses on the same date, including a General Objection to the other party's interrogatories on the basis that the interrogatories were excessive in number.

Well into Opposers' testimony period, Opposers *first* raised their concerns with the sufficiency of Applicant's discovery responses. However, a party may not complain about the sufficiency of a responding party's discovery during trial. *See* Trademark Rule 2.120(e) ("... The motion must be filed prior to the commencement of the first testimony period as originally set or



10-27-2008

as reset.”); *see also* TBMP §523.03.

Opposers’ testimony period was scheduled to close on October 22, 2007. During the entirety of Opposers’ testimony period, Opposers did not take the testimonial depositions of any witnesses, or submit any registrations or other evidence. Rather, on October 22, 2007 – the *final day* of its testimony period – Opposers filed their Motion for Leave.

Argument

As the moving party, Opposers bear the burden of establishing their right to amend its Notice of Opposition. Fed.R.Civ.Pro. 15. For the reasons discussed below, Opposers have failed to carry this burden.

A. The New Claim Sought to be Included Is Legally Insufficient.

It is axiomatic that “where the moving party seeks to add a new claim or defense, and the proposed pleading thereof is legally insufficient, or would serve no useful purpose, the Board normally will deny the motion for leave to amend.” *See* TBMP §507.02. Opposers’ proposed claim – namely, that Applicant lacked a bona fide intent to use its mark as demonstrated by the state of the discovery in this case – is legally insufficient and fails to state a claim upon which relief can be granted. Accordingly, it is respectfully submitted that Opposers’ Motion for Leave should be denied.

The only authority relied upon by Opposers in support of the legal sufficiency of their proposed claim is wholly irrelevant. Opposers cite *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034, 2035, 2036 (TTAB 1989) for the proposition that the “lack of a *bona-fide* intent to use the designation at issue on the goods and services listed in an application is proper grounds for opposition.” *See* Motion for Leave, p.5. However, the case is inapposite

since it involved an application filed under Section 1(a) (actual use), not Section 1(b) (intent to use). Indeed, the claim sought to be added by way of the motion to amend in *Century 21 Real Estate Corp.* alleged that the “applicant *did not use its mark as a service mark in commerce* prior to the filing of its application.” *Id.* (Emphasis supplied). Accordingly, the case does not support the Motion for Leave.

Not only did the authority cited by Opposers in support of the underlying claim not support the proposition for which it was cited, Opposers offered absolutely *no* authority for the proposition that the absence of discovery materials demonstrates Applicant’s lack of a bona-fide intention to use the opposed mark, as required by the Trademark Act. Accordingly, Opposers have again failed to carry their burden.

Moreover, even if it were a legitimate basis – which Opposers have failed to establish – Opposers confuse the status of Applicant’s discovery responses and production with an actual absence of evidence. Indeed, the former is a direct result of the objectionable nature of Opposers’ written discovery. For example, Opposers complain that Applicant has not “responded to any interrogatories demonstrating an intent to use the” opposed mark. Motion for Leave, p.5. However, Applicant did not respond to any of Opposers’ interrogatories because they were excessive in number, *see* Trademark Rule 2.120(d)(1); TBMP§405.03, and Applicant seasonably interposed a General Objection pursuant to the rules.¹ *Id.*

Similarly, Opposers complain that “Applicant has not produced any documents whatsoever”. *Id.* However, Opposers’ document requests improperly demanded that Applicant

¹ It is noted that Opposers also served a General Objection in response to Applicant’s interrogatories.

copy and mail said production to Opposers' counsel's office, *see* excerpt of Opposers' First Set of Requests for Production of Documents and Things, attached hereto as Exhibit A, to which Applicant seasonably objected. This improper demand is contrary to the requirements of the Trademark Rules. *See* Trademark Rule 2.120(d)(2)TBMP§406.03. Applicant was under no obligation to photocopy and mail its document production to Opposer. Indeed, the Board has confirmed this right:

We **will not sanction** defendant for failing to forward copies of documents to plaintiff. A party is not *required* to copy responsive documents and forward them to its adversary in response to document requests. Parties often do this as a reciprocal courtesy, but **it is sufficient for a responding party to make documents available, at the place they are normally kept**, for inspection and copying by the inquiring party.

Electronic Industries Assoc. v. Potega, 50 U.S.P.Q.2d 1775, 1777 (TTAB 1999) (italics in original, bold added). Accordingly, Applicant seasonably interposed a proper objection. *See* General Objection A ("Applicant objects to the production of documents at a place other than where such documents usually are kept.") found in Applicant's Response to Opposers' First Set of Requests for Production of Documents and Things, attached hereto as Exhibit B.

In short, while Applicant "did not produce a single document" (because it chose to not waive its proper objection to copying and mailing its document production to Opposer) and did not respond to Opposers' interrogatories (because, like Opposers, it interposed a General Objection based on the excessive number of interrogatories), as the above discussion adequately explains, this does not indicate an actual lack of evidence regarding the intent to use – simply,

the interposition by Applicant of timely objections to Opposer's discovery requests.²

For all the foregoing reasons, Applicant respectfully submits that Opposers' proposed claim is legally insufficient and, consequently, the Motion for Leave should be denied.

B. Applicant Will Be Prejudiced by Opposers' Dilatory/Bad Faith Motion

A motion to amend should be denied where the result of, *inter alia* "...bad faith or dilatory motive on the part of the movant" *Foman v. Davis*, 371 U.S. 178 (1962). As noted above, Opposers were dissatisfied with Applicant's (proper) objections, but failed to timely address these concerns. *See* Trademark Rule 2.120(e); TBMP §523.03. It would appear then that the Motion for Leave is intended as an alternative to a discovery motion, and/or an end run around the Board's rule precluding a party from addressing pre-trial discovery issues during trial. *See* Trademark Rule 2.120(e); TBMP §523.03. Accordingly, the Motion for Leave should be denied.

The timing of a motion to amend plays a large role in determining whether leave should be granted. *See* TBMP §507.02(a). As noted above, the Motion for Leave was filed on the final day of the testimony period. As such, it should be denied. The cases cited by Opposers are inapposite since the motions to amend were filed during the pre-trial stage. Indeed, in *Focus Int'l v. Pola Kasei Kogyo Kabusi Kaisha*, 22 USPQ2d 1316 (TTAB 1992), the Board reasoned:

The motion to amend was filed prior to opening of petitioner's testimony period and thus the discovery period may be reopened without undue prejudice to respondent.

² Significantly, Opposers have not filed a Motion to compel their discovery, to which Applicant has timely objected.

Obviously, with Opposers' Motion for Leave being filed on the last day of – rather than prior to – its testimony period, the rational of *Focus* decision cannot apply in this case.

CONCLUSION

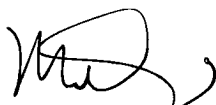
For all of the foregoing reasons, Applicant respectfully requests that the Board DENY Opposers' Motion for Leave.

Respectfully Submitted,

PEAK PERFORMANCE PRODUCTION AB

Dated: October 27, 2008

By: _____

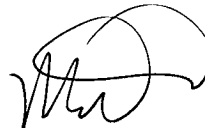

Simor L. Moskowitz
Matthew J. Cuccias
JACOBSON HOLMAN, PLLC
400 Seventh Street, N.W.
Washington, D.C. 20004
(202) 638-6666

CERTIFICATE OF SERVICE

I hereby certify that I have caused a true and correct copy of the foregoing Applicant's Brief in Opposition to Opposers' Motion for Leave to Amend the Notice of Opposition to be served by first-class mail, postage prepaid, upon counsel for Opposer:

Claudia T. Bogdanos
Jonathan A. Scharf
Quinn Emanuel Urquhart Oliver & Hedges, LLP
51 Madison Avenue
New York, NY 10010

this 27th day of October, 2008.



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Opposition No. 91168674

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OPPOSERS' MOTION FOR LEAVE
TO AMEND THE NOTICE OF OPPOSITION**

Exhibit A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 76/570,322
Published in the Official Gazette on July 12, 2005



Mark:

PRO-FOOTBALL, INC. and NFL
PROPERTIES LLC,

Opposers,

Opposition No. 91/168674

-against-

PEAK PERFORMANCE PRODUCTION
AB,

Applicant.


**OPPOSERS' FIRST SET OF REQUESTS FOR
PRODUCTION OF DOCUMENTS AND THINGS**

PLEASE TAKE NOTICE that pursuant to Rules 26 and 34 of the Federal Rules of Civil Procedure ("FRCP") and 37 C.F.R. § 2.120, Opposers Pro-Football, Inc. and NFL Properties LLC, by their attorneys Quinn, Emanuel, Urquhart, Oliver & Hedges, LLP, hereby request that Applicant Peak Performance Production AB produce and permit the undersigned to inspect and copy the documents and things described below at the offices of Quinn, Emanuel, Urquhart, Oliver & Hedges, LLP, 51 Madison Avenue, 22nd Floor, New York, New York 10010, or at a place agreed upon by the parties, on April 27, 2007 at 5:00 p.m.

Dated: New York, New York
March 23, 2007

Respectfully submitted,

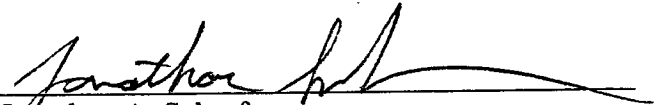
Quinn Emanuel Urquhart Oliver & Hedges,
LLP

By: 
Robert L. Raskopf
Claudia T. Bogdanos
Jonathan A. Scharf
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ATTORNEYS FOR OPPOSERS PRO-
FOOTBALL, INC. and NFL PROPERTIES,
LLC

CERTIFICATE OF SERVICE

I certify that on March 23, 2007, I caused to be served a copy of OPPOSERS' FIRST REQUESTS FOR ADMISSION, OPPOSERS' FIRST SET OF INTERROGATORIES, and OPPOSERS' FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS, by first-class mail to Simor Moskowitz, of Jacobson Homan PLLC, at 400 Seventh Street, N.W., Washington DC 20004.


Jonathan A. Scharf

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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**APPLICANT'S BRIEF IN OPPOSITION TO
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Exhibit B

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

PRO-FOOTBALL, INC. and NFL
PROPERTIES, LLC.,

Opposer,

v.

PEAK PERFORMANCE PRODUCTION AB

Applicant.

Opposition No. 91168674

**APPLICANT'S RESPONSE TO
OPPOSERS' FIRST SET OF REQUESTS
FOR PRODUCTION OF DOCUMENTS AND THINGS**

Applicant, Peak Performance Production AB, hereby submits the following responses and objections to Opposers' First Set of Requests for Production of Documents and Things ("Requests").

GENERAL OBJECTIONS

- A. Applicant objects to the production of documents at a place other than where such documents usually are kept.
- B. Applicant objects to the "Definitions and Instructions" and the Requests to the extent they seek to require Applicant to provide information for any non-party to this opposition.
- C. Applicant objects to the "Definitions and Instructions" and the Requests to the extent that they seek to impose any obligation beyond that required under the Federal Rules of Civil Procedure and/or the Trademark Rules of Practice.
- D. Applicant objects to the "Definitions and Instructions" and the Requests to the extent that they seek to impose any obligation to supplement Applicant's discovery responses

calling for a legal conclusion, and as seeking the confidential and/or attorney-client privileged information and material and/or attorney work product information of Applicant.

PEAK PERFORMANCE PRODUCTION AB

By: 

Simor L. Moskowitz
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(202) 638-6666

Dated: September 24, 2007
Attorney Docket No. I-5428

Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that on this 24th day of September, 2007, a true copy of the Applicant's Response to Opposers' First Requests for Admission was served by first-class mail, postage prepaid, upon counsel for Respondent:

Claudia T. Bogdanos
Jonathan A. Scharf
Quinn Emanuel Urquhart Oliver & Hedges, LLP
51 Madison Avenue
New York, NY 10010

